

### REMARKS

Applicant has reviewed and considered the Office Action mailed on August 20, 2008 and the references cited therein.

Claims 1, 3-5, 10, 15, 21, 46, and 57 are amended, claims 2 and 58 are canceled, and no claims are added; as a result, claims 1, 3-22, 46-50, 57, and 59-60 are now pending in this application.

### Specification

The Office Action requires correction to the Abstract section of the specification for various reasons. The Abstract section has been amended herein in a manner that is believed to address the Examiner's concerns.

### 35 USC § 101 Rejection of the Claims

Claims 46-50 were rejected under 35 USC § 101 as being directed to non-statutory subject matter.

The preamble of independent claim 46 has been amended herein to change the phrase "storage medium" to "computer readable storage medium." In addition, the specification has been amended to delete the only sentence that referred to instructions modulated onto a carrier wave. It is submitted that, even if the above-described sentence was not deleted from the specification, claim 46 would not encompass a carrier wave based medium as the claim specifically recites a "computer readable storage medium having instructions stored thereon." A carrier wave is not a "storage" medium and a carrier wave having instructions modulated onto it does not have instructions "stored thereon."

Based on the foregoing, it is respectfully requested that the rejection of independent claim 46 under 35 USC § 101 be withdrawn. Claims 47-50 were rejected under 35 USC § 101 based on their dependency from independent claim 46. Therefore, it is requested that the rejection of these claims also be withdrawn.

### 35 USC § 102 Rejection of the Claims

Claim 1 was rejected under 35 USC § 102(b) as being anticipated by *Doyle et al.* (U.S. Publication No. 2002/0095586) (hereinafter Doyle).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). The elements must be arranged as required by the claim . . . . *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990) (emphasis added).

Claim 1 is an independent claim directed to a wireless device comprising: (a) at least one biometric sensor to obtain biometric information about a user presently holding said wireless device when said wireless device is being held; (b) a biometric authentication unit to determine, based on said biometric information, whether said user presently holding said wireless device is authorized to use said wireless device; (c) a wireless transceiver to support wireless communication with a remote entity; and (d) a controller to control operation of said wireless device, wherein said controller is programmed to change operational characteristics of said wireless device based on whether said wireless device is presently being held, wherein said controller is programmed to request access to a network, using said wireless transceiver, when said wireless device is being held and said biometric authentication unit indicates that said user presently holding said wireless device is authorized to use said wireless device.

At a minimum, Doyle does not disclose or suggest "a controller ... [that] is programmed to request access to a communications network, using said wireless transceiver, when said wireless device is being held and said biometric authentication unit indicates that said user presently holding said wireless device is authorized to use said wireless device." As the language of the claim makes clear, the controller requests access to the communications network when (i) the wireless device is being held and (ii) the biometric authentication unit indicates that the user presently holding the wireless device is authorized to use the wireless device. That is, the controller is programmed so that it must first be determined that the user is authorized to use the wireless device before the request for network access is made using the wireless transceiver. The network itself may then have to check whether the user is authorized to use the network. Doyle does not show a controller having such programming.

Based on the foregoing, it is submitted that claim 1 is not anticipated by Doyle. Reconsideration and allowance of claim 1 is therefore respectfully requested.

35 USC § 103 Rejection of the Claims

Claims 2-4, 6, 13-15, 17, 46 and 48 were rejected under 35 USC § 103(a) as being unpatentable over *Doyle et al.* (U.S. Publication No. 2002/0095586).

To support an obviousness rejection, the Examiner must show that “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. § 103(a) [emphasis added]. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

“Office personnel fulfill the critical role of fact finder when resolving the *Graham* inquiries. ... Factual findings made by Office personnel are the necessary underpinnings to establish obviousness.” MPEP 2141(II) [emphasis added]. The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385 (2007). In *KSR*, the Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). MPEP 2141.02 (I)

All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Claim 15 is an independent claim directed to a computer implemented method comprising: (a) sensing that a wireless device has been picked up by a user; (b) determining, after sensing that said wireless device has been picked up, whether said user is authorized to use said wireless device based on collected biometric information; and (c) when said user is determined to be authorized to use said wireless device, requesting access to a network via a wireless link. Claim 15 has been amended herein to clarify that the claimed method is computer implemented.

Doyle does not disclose or suggest “when said user is determined to be authorized to use said wireless device, requesting access to a network via a wireless link.” That is, network access is not requested until it is determined that the user that picked up the wireless device is authorized to use the wireless device. Doyle does not teach such a method. The Examiner takes the position that Doyle renders claim 15 obvious because it states that “If the authentication process of Block 220 completes successfully, then the security core may trust the application processor.” However, this language does not teach or suggest the sending of a network access request via wireless link when a user is determined to be authorized to use the wireless device. At best, this language indicates that it might be possible to send an access request after the authentication process of Block 220 has successfully completed because the security core 150 may trust the application processor 170.

In addition to the above, it is submitted that the Examiner has not accurately ascertained the differences between the prior art and the subject matter of claim 15 as required by *Graham*. Also, it is submitted that the Examiner has failed to provide the level of articulated reasoning required by *KSR* to support an obviousness rejection.

Based on the foregoing, it is submitted that claim 15 is not rendered obvious by Doyle. Reconsideration and allowance of claim 15 is therefore respectfully requested. Independent claim 46 is allowable for at least the same reasons described above in connection with claim 15.

Claims 3-4, 6, and 13-14; claim 17; and claim 48 are dependent claims that depend either directly or indirectly from independent claims 1, 15, and 46, respectively. Consequently, these claims are allowable for at least the same reasons as their corresponding base claims. These claims also provide further bases for patentability.

Claim 2 has been canceled herein without prejudice.

Claims 5, 21, and 22 were rejected under 35 USC § 103(a) as being unpatentable over Doyle in combination with *Loveland* (U.S. Publication No. 2003/0070091).

Claim 5 and claims 21 and 22 are dependent claims that depend either directly or indirectly from independent claims 1 and 15, respectively. Consequently, these claims are allowable for at least the same reasons as their corresponding base claims. These claims also provide further bases for patentability.

Claims 7, 8, 16 and 47 were rejected under 35 USC § 103(a) as being unpatentable over Doyle in combination with *Bi et al.* (U.S. Patent No. 7,113,173) (hereinafter Bi).

Claims 7 and 8, claim 16, and claim 47 are dependent claims that depend either directly or indirectly from independent claims 1, 15, and 46, respectively. Consequently, these claims are allowable for at least the same reasons as their corresponding base claims. These claims also provide further bases for patentability.

Claims 9, 18, 19, 49, and 50 were rejected under 35 USC § 103(a) as being unpatentable over Doyle in combination with *Knouse et al.* (U.S. Publication No. 2003/0074580).

Claim 9, claims 18 and 19, and claims 49 and 50 are dependent claims that depend either directly or indirectly from independent claims 1, 15, and 46, respectively. Consequently, these claims are allowable for at least the same reasons as their corresponding base claims. These claims also provide further bases for patentability.

Claims 10 and 11 were rejected under 35 USC § 103(a) as being unpatentable over Doyle in combination with *Reisman* (U.S. Patent No. 6,769,009) (hereinafter Reisman).

Claims 10 and 11 are dependent claims that depend either directly or indirectly from independent claim 1. Consequently, these claims are allowable for at least the same reasons as claim 1. These claims also provide further bases for patentability.

Claim 12 was rejected under 35 USC § 103(a) as being unpatentable over Doyle in combination with *Reisman*.

Claim 12 is a dependent claim that depends directly from independent claim 1. Consequently, claim 12 is allowable for at least the same reasons as claim 1. Claim 12 also provides further basis for patentability.

Claim 57 and 58 were rejected under 35 USC § 103(a) as being unpatentable over Doyle in combination with *Hayes et al.* (U.S. Patent No. 5,949,383) (hereinafter Hayes).

With regard to independent claim 57, neither Doyle nor Hayes, either alone or in combination, discloses or suggests, “a controller ... [that] is programmed to request access to a communications network, using said wireless transceiver, when said wireless device is being held and said biometric authentication unit indicates that said user presently holding said wireless device is authorized to use said wireless device.” As the language of the claim makes clear, the controller requests access to the communications network when (i) the wireless device is being held and (ii) the biometric authentication unit indicates that the user presently holding the wireless device is authorized to use the wireless device. That is, the controller is programmed so that it must first be determined that the user is authorized to use the wireless device before the request for network access is made using the wireless transceiver. The network itself may then have to check whether the user is authorized to use the network. Neither Doyle nor Hayes teaches or suggests a controller having such programming.

Claim 58 has been canceled herein without prejudice.

Claim 59 and 60 were rejected under 35 USC § 103(a) as being unpatentable over Doyle and Hayes in combination with Bi.

Claims 59 and 60 are dependent claims that each depend directly from independent claim 57. Consequently, these claims are allowable for at least the same reasons as claim 57. These claims also provide further bases for patentability.

**Conclusion**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (480-948-3745) to facilitate prosecution of this application.

Respectfully submitted,

NIKHIL M. DESHPANDE ET AL.

By their Representatives,

**CUSTOMER NUMBER: 45643**  
480-948-3745

Date: January 21, 2009

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 21st day of January, 2009.

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